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REMARKS**Objections to the Specification**

The Office Action objected to informalities in the specification. Applicants have amended the specification to address each of the informalities. More specifically, Applicants amended the paragraph beginning at page 18, line 15, of the original specification by deleting "126" after the phrase "services gateway (" and inserting "106" after the phrase "services gateway (." Applicants also amended the paragraph beginning at page 23, line 13, of the original specification by deleting "106" after the phrase "services gateway (" and inserting "130" after the phrase "services gateway (."

Claim Rejections

Claims 1-7 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. As will be shown below, the Office Action has not established a prima facie case for rejecting claims 1-7 under 35 U.S.C. § 101, and Applicants' claims are directed to patentable subject matter. Claims 1-18 stand rejected under 35 U.S.C § 102(b) as being anticipated by Snell *et al.* (U.S. Patent No. 5,518,001). As will be shown below, Snell, does not anticipate methods, systems, and computer program products for administering devices as claimed in the present application. Claims 1-18 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-18.

Claim Rejections – 35 U.S.C. § 101

Claims 1-7 stand rejected under 35 U.S.C § 101 on grounds that these claims are directed to non-statutory subject matter. The Office Action at numbered paragraph 3 states:

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Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, the acts are not being applied to appropriate subject matter. Shrader, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of number, does not manipulate appropriate subject matter and thus cannot constitute a statutory process. See MPEP 2106 IV B 1.

For the claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the progress of science and the useful arts (i.e., the physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the process must somehow apply, involve, use, or advance the technological arts.

Applicants note in response that a claimed invention constitutes patentable subject matter under 35 U.S.C. § 101 if the claimed invention as a whole produces a “useful, concrete and tangible result.” *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1373, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). In rejecting claim 1 under 35 U.S.C. § 101, “[o]ffice personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.” *Manual of Patent Examining Procedure* § 2106 II A. In this case, the Office Action does not offer any explanation as to why Applicants’ claims 1-7 are directed to solely an abstract idea, the manipulation of abstract ideas, or as to why Applicants’ claims 1-7 do not produce a useful result. The Office Action therefore does

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not establish a prima facie case of non-statutory subject matter under 35 U.S.C. § 101, and the rejections should be withdrawn.

In addition, when the Office Action rejects a claim under 35 U.S.C. § 101, "Office personnel must expressly state how the language of the claims has been interpreted to support the rejection." *Manual of Patent Examining Procedure* § 2106 II A. In this case, the Office Action states nothing to indicate "how the language of the claims has been interpreted to support the rejection." Because the Office Action does not provide any statement of explanation as to how claims 1-7 have been interpreted to support the rejection under 35 U.S.C. § 101, the Office Action does not comply with *Manual of Patent Examining Procedure* § 2106 II A. The Office Action therefore does not establish a prima facie case of non-statutory subject matter under 35 U.S.C. § 101, and the rejections should be withdrawn.

In the absence of a prima facie showing of unpatentable subject matter under 35 U.S.C. § 101, Applicants are under no obligation to respond further on this issue. Nevertheless, in an effort to move the case forward, Applicants demonstrate that the present claims clearly claim a patentable invention within the meaning of 35 U.S.C. § 101. Applicants' claims clearly lie within a safe harbor of 35 U.S.C. § 101. MPEP § 2106 IV B(2)(b)(i) states that a "statutory process is one that requires the measurements of physical objects or activities to be transformed outside of the computer into computer data (*In re Gelnovatch*, 595 F.2d 32, 41 n. 7, 201 USPQ 136, 145 n. 7 (CCPA 1979) (data-gathering step did not measure physical phenomenon); *Arrhythmia*, 958 F.2d at 1056, 22 USPQ2d at 1036), where the data comprises signals corresponding to physical objects or activities external to the computer system, and where the process causes a physical transformation of the signals which are intangible representations of the physical objects or activities. *Schrader*, 22 F.3d at 294, 30 USPQ2d at 1058-59, 22 USPQ2d at 1037-38; *Abele*, 684 F.2d at 909, 214 USPQ at 688; *In re Taner*, 681 F.2d 787, 790, 214 USPQ 678, 681 (CCPA 1982)." Applicants claims contain measurements of physical objects or activities to be transformed outside of the computer into computer data because the user metrics of claims 1-7 are representations of measured indications of user condition. In fact, the

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Office Action at numbered paragraph 5 acknowledges that Applicants' claims measure physical objects or activities to be transformed outside of the computer into computer data stating "Examiner Note (EN): A metric vector is comprised of different measurements of a user's conditions as stated by the applicant on paragraph 164, lines 1-6." Because claims 1-7 fall within the safe harbor of 35 U.S.C. § 101, claims 1-7 in fact claim a method that is a statutory process within the meaning of 35 U.S.C. § 101. Claims 1-7 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-7.

Claim Rejections – 35 U.S.C. §102 Over Snell

Claims 1-18 stand rejected under 35 U.S.C § 102(b) as being anticipated by Snell (U.S. Patent No. 5,518,001). To anticipate claims 1-18 under 35 U.S.C. § 102(b), two basic requirements must be met. The first requirement of anticipation is that Snell must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Snell must enable Applicants' claims. Snell does not meet either requirement and therefore does not anticipate Applicants' claims.

Snell Does Not Disclose Each and Every Element
Of The Claims Of The Present Application

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Snell does not disclose each and every element of claim 1, and Snell therefore cannot be said to anticipate the claims of the present application within the meaning of 35 USC 102.

Independent claim 1 of the present application claims:

A method for administering devices, the method comprising:

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creating a user metric vector comprising a plurality of disparate user metrics;

creating a user metric space comprising a plurality of metric ranges;

receiving, from a user, a value for a user preference for a device;

determining whether a user metric vector is outside the user metric space;

if the user metric vector is outside a user metric space, identifying an action;

executing the action; and

setting the value of a user preference for a device in dependence upon the value received from the user.

Snell Does Not Disclose Creating A User Metric Vector
Comprising A Plurality Of Disparate User Metrics

Regarding the first element of claim 1, the Office Action at page 3 states:

Snell anticipates creating a user metric vector comprising a plurality of disparate user metrics (Snell, C2: 17-22; Examiner Note (EN): A metric vector is comprised of different measurements of a user's conditions as stated by the applicant on paragraph 164, lines 1-6);

The Office Action takes the position that Snell at column 2, lines 17-22, discloses the first element of claim 1 of the present application. Applicants note in response that what Snell at column 2, lines 17-22, in fact discloses is:

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Therefore, in accordance with the present invention, a cardiac device is provide that has multiple sensor for measuring various physiological parameters, such as a blood flow sensor, a blood oxygen level sensor, an activity sensor, a temperature sensor, a respiration rate sensor, or a cardiac wall motion sensor.

That is, Snell at column 2, lines 17-22, discloses taking various measurements of a patient's physiological conditions. Taking various measurements of a patient's physiological condition, however, is not creating a user metric vector comprising a plurality of disparate user metrics as claimed in the present application. In fact, Snell does not even mention a creating a user metric vector comprising a plurality of disparate user metrics or user metric vectors. As such, Snell does not disclose each and every element of independent claim 1, the rejections should be withdrawn, and the claims should be allowed.

Snell Does Not Disclose Creating A User Metric Space
Comprising A Plurality Of Metric Ranges

Regarding the second element of claim 1, the Office Action at page 4 states:

creating a user metric space comprising a plurality of metric ranges receiving, from a user, a value for a user preference for a device (Snell, C2: 22-28; Examiner Note (EN): By selecting the amount of sensors to use, a metric space is defined);

The Office Action takes the position that Snell at column 2, lines 22-28, discloses the second element of claim 1 of the present application. Applicants note in response that what Snell at column 2, lines 22-28, in fact discloses is:

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A physician can direct the cardiac stimulating device to store data from some or all of the sensors. Data that is measured by the sensors is stored in memory within the cardiac device. The data may be retained either automatically, (e.g., when an abnormal cardiac event such as an arrhythmia is detected), or when the cardiac device is signaled by a patient.

That is, Snell at column 2, lines 22-28, discloses a physician directing a cardiac stimulating device to store data from some or all of the sensors. A physician directs a cardiac stimulating device to store data from some or all of the sensors. Snell's storing data from some or all of the sensors is not creating a user metric space comprising a plurality of metric ranges as claimed in the present application. In fact, Snell does not even mention a creating a user metric space, a plurality of metric ranges, a metric space or a metric range. Snell therefore does not disclose each and every element of independent claim 1, the rejections should be withdrawn, and the claims should be allowed.

Snell Does Not Disclose Determining Whether A User
Metric Vector Is Outside The User Metric Space

Regarding the fourth element of claim 1, the Office Action at page 4 states:

determining whether a user metric vector is outside the user metric space
(Snell, C2: 25-28; Examiner Note (EN): An abnormal event is outside the metric space)

That is, the Office Action takes the position that Snell at column 2, lines 25-28, discloses the fourth element of claim 1 of the present application. Applicants note in response that what Snell at column 2, lines 25-28, in fact discloses is:

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The data may be retained either automatically, (e.g., when an abnormal cardiac event such as an arrhythmia is detected), or when the cardiac device is signaled by a patient.

That is, Snell at column 2, lines 25-28, discloses automatically retaining the measuring data when an abnormal cardiac event is detected. Automatically retaining the measuring data when an abnormal cardiac event is detected is not determining whether a user metric vector is outside the user metric space as claimed in the present application. Snell at column 2, lines 25-28, does not even once mention anything regarding determining whether a user metric vector is outside the user metric space. In fact, Snell does not even mention determining whether a user metric vector is outside the user metric space, a user metric vector, or a user metric space. Snell therefore does not disclose each and every element of independent claim 1, the rejections should be withdrawn, and the claims should be allowed.

Snell Does Not Disclose If The User Metric Vector
Is Outside A User Metric Space, Identifying An
Action Or Executing The Action

Regarding the fifth and sixth elements of claim 1, the Office Action at page 4 states:

if the user metric vector is outside a user metric space, identifying an
action (Snell, C6: 61-65); executing the action (Snell, C6: 61-65);

That is, the Office Action takes the position that Snell at column 6, lines 61-65, discloses the fifth and sixth element of claim 1 of the present application. Applicants note in response that what Snell at column 6, lines 61-65, in fact discloses is:

means for detecting when a predetermined cardiac condition occurs; and
means for automatically retaining the data in the memory when the
predetermined cardiac condition is detected by the means for detecting.

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That is, column 6, lines 61-65 of Snell discloses detecting when a predetermined cardiac condition occurs and automatically retaining the data in the memory when the predetermined cardiac condition is detected. Snell's detecting when a predetermined cardiac condition occurs and automatically retaining the data in the memory when the predetermined cardiac condition is detected is not identifying an action and executing the action if the user metric vector is outside a user metric space as claimed in the present application. Snell at column 6, lines 61-65, does not even once a user metric vector or a user metric space. Snell therefore does not disclose each and every element of independent claim 1, the rejections should be withdrawn, and the claims should be allowed.

Snell Does Not Disclose Setting The Value Of A User
Preference For A Device In Dependence Upon
The Value Received From The User

Regarding the seventh element of claim 1, the Office Action at page 4 states:

setting the value of a user preference for a device in dependence upon the value received from the user (Snell, C5: 48-53).

That is, the Office Action takes the position that Snell at column 5, lines 48-53, discloses the seventh element of claim 1 of the present application. Applicants note in response that what Snell at column 5, lines 48-53, in fact discloses is:

Preferably, the physician can selectively limit the number of sensors 27 and 29 from which data are stored in the memory to a subset of the total number available by high-lighting corresponding icons on the display 52 or by entering the name of the sensors 27 and 29 to be selected via the input interface 50 (step 204 in FIG 5).

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That is, column 5, lines 48-52 disclose limiting the number of sensors from which data is stored. Limiting the number of sensors from which data is stored is not setting the value of a user preference for a device in dependence upon the value received from the user as claimed in the present application. In fact, Snell does not even mention user preferences, metric vectors, or metric spaces anywhere in the reference. Snell therefore does not disclose each and every element of independent claim 1, the rejections should be withdrawn, and the claims should be allowed.

Snell Does Not Enable Each and Every Element
Of The Claims Of The Present Application

Not only must Snell disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Snell must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d at 273, 158 USPQ at 600. The meaning of *Hoeksema* for the present case is that unless Snell places Applicants' claims in the possession of a person of ordinary skill in the art, Snell is legally insufficient to anticipate Applicants' claims under 35 USC 102(b).

Snell in fact does not place each and every element of independent claim 1 in the possession of a person of skill in the art. As mentioned above, independent claim 1 of the present application claims:

A method for administering devices, the method comprising:

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creating a user metric vector comprising a plurality of disparate user metrics;

creating a user metric space comprising a plurality of metric ranges;

receiving, from a user, a value for a user preference for a device;

determining whether a user metric vector is outside the user metric space;

if the user metric vector is outside a user metric space, identifying an action;

executing the action; and

setting the value of a user preference for a device in dependence upon the value received from the user.

Snell Does Not Place In The Possession Of A Person Skilled
In The Art Creating A User Metric Vector Comprising
A Plurality Of Disparate User Metrics

Regarding the first element of claim 1, the Office Action at page 3 states:

Snell anticipates creating a user metric vector comprising a plurality of disparate user metrics (Snell, C2: 17-22; Examiner Note (EN): A metric vector is comprised of different measurements of a user's conditions as stated by the applicant on paragraph 164, lines 1-6);

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The Office Action takes the position that Snell at column 2, lines 17-22, discloses the first element of claim 1 of the present application. Applicants note in response that what Snell at column 2, lines 17-22, in fact discloses is:

Therefore, in accordance with the present invention, a cardiac device is provide that has multiple sensor for measuring various physiological parameters, such as a blood flow sensor, a blood oxygen level sensor, an activity sensor, a temperature sensor, a respiration rate sensor, or a cardiac wall motion sensor.

That is, Snell at column 2, lines 17-22, discloses taking various measurements of a patient's physiological conditions. Taking various measurements of a patient's physiological condition, however, is not creating a user metric vector comprising a plurality of disparate user metrics as claimed in the present application. In fact, Snell does not even mention a creating a user metric vector comprising a plurality of disparate user metrics or user metric vectors. As such, Snell does not place each and every element of independent claim 1 in the possession of a person of skill in the art, the rejections should be withdrawn, and the claims should be allowed.

Snell Does Not Place In The Possession Of A Person
Skilled In The Art Creating A User Metric Space
Comprising A Plurality Of Metric Ranges

Regarding the second element of claim 1, the Office Action at page 4 states:

creating a user metric space comprising a plurality of metric ranges receiving, from a user, a value for a user preference for a device (Snell, C2: 22-28; Examiner Note (EN): By selecting the amount of sensors to use, a metric space is defined);

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The Office Action takes the position that Snell at column 2, lines 22-28, discloses the second element of claim 1 of the present application. Applicants note in response that what Snell at column 2, lines 22-28, in fact discloses is:

A physician can direct the cardiac stimulating device to store data from some or all of the sensors. Data that is measured by the sensors is stored in memory within the cardiac device. The data may be retained either automatically, (e.g., when an abnormal cardiac event such as an arrhythmia is detected), or when the cardiac device is signaled by a patient.

That is, Snell at column 2, lines 22-28, discloses a physician directing a cardiac stimulating device to store data from some or all of the sensors. A physician directs a cardiac stimulating device to store data from some or all of the sensors. Snell's storing data from some or all of the sensors is not creating a user metric space comprising a plurality of metric ranges as claimed in the present application. In fact, Snell does not even mention a creating a user metric space, a plurality of metric ranges, a metric space or a metric range. Snell therefore does not place each and every element of independent claim 1 in the possession of a person of skill in the art, the rejections should be withdrawn, and the claims should be allowed.

Snell Does Not Place In The Possession Of A Person
Skilled In The Art Determining Whether A User
Metric Vector Is Outside The User Metric Space

Regarding the fourth element of claim 1, the Office Action at page 4 states:

determining whether a user metric vector is outside the user metric space
(Snell, C2: 25-28; Examiner Note (EN): An abnormal event is outside the metric space)

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That is, the Office Action takes the position that Snell at column 2, lines 25-28, discloses the fourth element of claim 1 of the present application. Applicants note in response that what Snell at column 2, lines 25-28, in fact discloses is:

The data may be retained either automatically, (e.g., when an abnormal cardiac event such as an arrhythmia is detected), or when the cardiac device is signaled by a patient.

That is, Snell at column 2, lines 25-28, discloses automatically retaining the measuring data when an abnormal cardiac event is detected. Automatically retaining the measuring data when an abnormal cardiac event is detected is not determining whether a user metric vector is outside the user metric space as claimed in the present application. Snell at column 2, lines 25-28, does not even once mention anything regarding determining whether a user metric vector is outside the user metric space. In fact, Snell does not even mention determining whether a user metric vector is outside the user metric space, a user metric vector, or a user metric space. Snell therefore does not place each and every element of independent claim 1 in the possession of a person of skill in the art, the rejections should be withdrawn, and the claims should be allowed.

Snell Does Not Place In The Possession Of A Person Skilled
In The Art If The User Metric Vector Is Outside A User
Metric Space, Identifying An Action Or Executing The Action

Regarding the fifth and sixth elements of claim 1, the Office Action at page 4 states:

if the user metric vector is outside a user metric space, identifying an action (Snell, C6: 61-65); executing the action (Snell, C6: 61-65);

That is, the Office Action takes the position that Snell at column 6, lines 61-65, discloses the fifth and sixth element of claim 1 of the present application. Applicants note in response that what Snell at column 6, lines 61-65, in fact discloses is:

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means for detecting when a predetermined cardiac condition occurs; and
means for automatically retaining the data in the memory when the
predetermined cardiac condition is detected by the means for detecting.

That is, column 6, lines 61-65 of Snell discloses detecting when a predetermined cardiac condition occurs and automatically retaining the data in the memory when the predetermined cardiac condition is detected. Snell's detecting when a predetermined cardiac condition occurs and automatically retaining the data in the memory when the predetermined cardiac condition is detected is not identifying an action and executing the action if the user metric vector is outside a user metric space as claimed in the present application. Snell at column 6, lines 61-65, does not even once a user metric vector or a user metric space. Snell therefore does not place each and every element of independent claim 1 in the possession of a person of skill in the art, the rejections should be withdrawn, and the claims should be allowed.

Snell Does Not Place In The Possession Of A Person
Skilled In The Art Setting The Value Of A User
Preference For A Device In Dependence Upon
The Value Received From The User

Regarding the seventh element of claim 1, the Office Action at page 4 states:

setting the value of a user preference for a device in dependence upon the
value received from the user (Snell, C5: 48-53).

That is, the Office Action takes the position that Snell at column 5, lines 48-53, discloses the seventh element of claim 1 of the present application. Applicants note in response that what Snell at column 5, lines 48-53, in fact discloses is:

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Preferably, the physician can selectively limit the number of sensors 27 and 29 from which data are stored in the memory to a subset of the total number available by high-lighting corresponding icons on the display 52 or by entering the name of the sensors 27 and 29 to be selected via the input interface 50 (step 204 in FIG 5).

That is, column 5, lines 48-52 disclose limiting the number of sensors from which data is stored. Limiting the number of sensors from which data is stored is not setting the value of a user preference for a device in dependence upon the value received from the user as claimed in the present application. In fact, Snell does not even mention user preferences, metric vectors, or metric spaces anywhere in the reference. Snell therefore does not place each and every element of independent claim 1 in the possession of a person of skill in the art, the rejections should be withdrawn, and the claims should be allowed.

Relations Among Claims

Independent claims 7 and 13 claim system and computer program product aspects of the method claimed in independent claim 1. Independent claims 7 and 13 therefore are patentable for the same reasons that independent claim 1 is patentable as described above. Dependent claims 2-6, 8-12, and 14-18 depend respectively from independent claims 1, 7, and 13. The dependent claims include each and every limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand.

Conclusion

Claims 1-7 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. As described above, the Office Action has not established a prima facie case for rejecting claims 1-7 under 35 U.S.C. § 101, and Applicants' claims are directed to patentable subject matter. Claims 1-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Snell *et al.* (U.S. Patent No. 5,518,001). As described above, Snell does not disclose each and every element of Applicants' claims, and Snell

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does not enable Applicants' claims. Snell therefore does not anticipate Applicants' claims within the meaning of 35 U.S.C § 102(b). Claims 1-18 are therefore patentable. The rejection of all claims 1-18 in the present case should therefore be withdrawn, and the claims should be allowed. Applicants respectfully request reconsideration of claims 1-18.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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